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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of: §
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RABINDRANATH DUTTA §
§ Examiner: **DOUGLAS B. BLAIR**
§
Serial No.: **09/542,517** §
§ Art Unit: 2142
§
Filed: **April 3, 2000** §
§
§
For: **METHOD, SYSTEM AND** §
PROGRAM FOR EFFICIENTLY §
DISTRIBUTING SERIAL ELECTRICAL §
PUBLICATIONS §

APPEAL BRIEF UNDER 37 C.F.R. § 1.192

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Sir:

This Appeal Brief is submitted in triplicate in support of an Appeal of the Examiner's final rejection of Claims 1-21 in the above-identified application. A Notice of Appeal was filed in this case on January 9, 2004 and received in the Patent Office on January 12, 2004. A Request for a 1 month extension of time is attached along with a check for $110.00 covering the fees for that extension. No other extension of time or fee is believed to be required. Please charge the fee of $320.00 due under 37 C.F.R. § 1.17(c) for filing the brief, as well as any additional required fees, to IBM Deposit Account No. 09-0447.

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REAL PARTY IN INTEREST

The real party in interest in the present Appeal is International Business Machines Corporation, the Assignee of the present application, as evidenced by the Assignment recorded at reel 010737 and frame 0942.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant, the Appellant's legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-21 stand finally rejected by the Examiner as noted in the Final Office Action dated October 9, 2003 and the Advisory Action dated January 9, 2004.

STATUS OF AMENDMENTS

No amendments to the claims have been made subsequent to the final rejection that leads to this appeal.

SUMMARY OF THE INVENTION

Appellant's invention provides a method and system that enables server-directed transmission of an electronic publication to a subscriber, whereby a second issue of the publication is transmitted only after a dynamic determination that the previous/first issue of the publication has been opened on the subscriber's computer system (see Summary, page 6, lines 8-18).

The push engine transmits the first issue of the publication to the subscriber's inbox or mail server. A cookie is transmitted along with the issue to track when the issue is opened within the user's mailbox (id., lines 12-14). The "opened" status of the email is registered within the cookie and a "cookie response" message is automatically returned to the status manager of the push engine. The push engine thus receives confirmation that the particular user has opened the previous issue before a next issue is transmitted (see page 12, lines 9-19). The next issue is

transmitted only when the previous issue has been opened. When the first issue has not been opened, the push engine withholds transmitting that next issue until a confirmation signal (i.e., a cookie response) is received indicating that the previous issue has been opened.

The invention overcomes overloading and other problems with conventional "push" operation when a "push engine" automatically transmits a series of issues of the publication (at pre-established time intervals) regardless of whether the issues are being opened by the user. This often results in the user's mailbox becoming overloaded/full with unread publications, particularly if the user does not access his computer system (or mailbox) for an extended period of time (for example, while the user is on vacation) (see page 5, lines 12-21).

Appellant's claimed invention recites several novel implementation features, including:

(1) "a status manager that determines whether said first issue has been opened by said subscriber, and that allows said push engine to transmit a second issue to said subscriber **only after** determining that said first issue has been opened;" (Claim 8, emphasis added); and

(2) said push engine transmits a hypertext transfer protocol (HTTP) **cookie** to said subscriber with said first issue; said status update comprises a **cookie response** received from said subscriber; and said cookie response corresponds to said HTTP cookie and indicates that client software has been utilized to open said first issue" (Claim 12, emphasis added).

ISSUES

The primary issues for appeal are whether Griebenow (U.S. Pat. No. 5,850,520) or the combination of Griebenow and Hoyle (U.S. Pat. No. 6,141,010) renders Appellant's Claims 1-21 unpatentable under 35 U.S.C. § 103(a). Resolution of those issues requires a determination whether Griebenow suggests to one skilled in the art (1) an electronic publication method that transmits a second issue of an electronic publication to a user **only after** the first/previous issue of the publication has been opened and (2) using an http cookie and associated cookie response to dynamically track at the publication server when a first issue of the electronic publication

transmitted to a user has been opened. These features are provided by Appellant's exemplary claims.

GROUPING OF THE CLAIMS

For purposes of this Appeal, Claims 1-4, 7-11, and 14-18 stand or fall together as Group I, and Claims 5-6, 12-13, and 19-21 stand or fall together as Group II.

ARGUMENT

I. EXAMINER'S REJECTION OF APPELLANT'S GROUP I CLAIMS AS BEING UNPATENTABLE OVER GRIEBENOW IS NOT WELL FOUNDED AND SHOULD BE REVERSED.

At paragraph 6 of the Final Office Action, Examiner rejected Claims 1-3, 7-10 and 14-17 under 35 U.S.C. § 103(a), as being unpatentable over Griebenow. Appellant hereby incorporates by reference the arguments provided in Amendment A and Response B with respect to the above rejection. Specifically, Appellant reiterates that Griebenow does not suggest to one of ordinary skill in the art "a status manager that ... allows said push engine to transmit a second issue to said subscriber **only after** determining that said first issue has been opened" (emphasis added), as provided by Appellant's exemplary Claim 8.

At the end of numbered paragraph 7 of the Final Action, Examiner states that "Giebenow does not explicitly teach allowing the transmission of a second issue only when it has been determined that the first issue is opened" (emphasis added). Examiner then offers a contradictory analysis by referencing col. 10, lines 30-48 of Griebenow to support a teaching of a status manager and the functional features associated with that mechanism.

Col. 10, lines 30-48 is completely devoid of any reference to or suggestion of a status manager that determines when an issue of a publication has been opened and then allows a push engine to transmit the next (second) issue only after the previous (first) issue has been opened. In contrast to the claimed functionality, that section of Griebenow discusses displaying advertising on pages of the electronic publication, where the reading application "cause an advertisement to appear after the electronic publication has been in use for a predetermined

amount of time" (e.g., every 15 minutes) (id. at lines 35-38). Also, the viewing of a next advertisement occurs automatically (based on a pre-established time period), regardless of whether or not the user opens the advertisement. See, for example, lines 30-34, which describes how "[p]assing a pointer over portions of the advertisement could trigger the presentation of a multimedia item." That section does not require the user actually taking any action for the next advertisement to appear. Notably also, Griebenow describes the advertisement appearing on an opened electronic publication but teaches away from any steps/mechanism that determines when the next issue of the publication can/should be transmitted.

The remaining parts of that section discuss how a consumer is prevented from avoiding viewing the advertisement. Thus, Griebenow provides that "[t]he advertising timing carries over to the next time... prevent a consumer from trying to avoid viewing advertising" (id. at lines 38-48). Clearly, the section of Griebenow relied upon by Examiner does not teach or suggest a status manager causing a push of a second issue of a publication only after the first issue has been opened.

Even col. 9, lines 5-11, utilized to support Examiner's summary of the reasons why the above section could be extended to make the Claim feature obvious, fails to support such a conclusion. That section merely describes "a method ... to create a customized electronic publication" where "the advertising in the electronic publication is customized for the consumer." Griebenow further states that "the content of the electronic publication could also be customized using a similar method." This description, however, supports Appellant's position that Griebenow teaches away from the specific functionality of Appellant's claimed invention since the advertisement opens automatically (at pre-established time periods) on the consumer's device and is displayed regardless of whether or not the consumer reads the previous advertisement or takes any action that may be considered "opening" the advertisement.

An extension of a preset time period for displaying an advertisement to the content of an electronic publication merely allows the content to be displayed at that preset time interval without user input/selection. Taken in even its broadest light, this extension only suggests that the publication's content pops up on the consumer's computer system every period (e.g., fifteen

minutes) that (1) the consumer's computer system is on or (2) a certain application is running. This extension does not suggest, however, **preventing** a push of a **next issue** of a publication **until after** the first (or previous) issue has been read.

With respect to the other features of Appellant's Group I claims, Examiner relies almost exclusively on Col. 8, lines 19-56 to support the obviousness rejections. Careful analysis of that section of Giebenow, however, indicates that that section is devoid of any teaching or suggestion of several of the features provided within the Group I claims. For example, col. 8, lines 33-56 does not teach or suggest a status manager determining whether the first (publication) issue has been opened by a subscriber. That section describes a timing engine that determines "whether it is time to send a renewal notice to the consumer because the consumer's subscription ... has lapsed or is about to lapse." The timing engine sends a notice (i.e., an item functionally different and separate from the publication) with a return receipt requested to provide electronic verification of the <u>receipt of the renewal notice</u>.

There is no condition placed on transmitting a second issue based a first/previous issue having been opened. More specifically, there is no condition for transmitting the second issue only when the return receipt for the notice is received. In fact, Griebenow's timing engine keeps sending the next publication (issues) out until the subscription lapses, regardless of whether or not the subscriber actually opens the previous issues or the renewal notice.

Advisory Action Supplemental Arguments

Examiner provides additional arguments within the Advisory Action, in which Examiner incorrectly states that Griebenow's process of determining whether an inclusion criterion has been met (at col. 9, lines 49-59) teaches/suggests the above features of exemplary Claim 8. The inclusion criteria referenced by Griebenow indicates when the advertisement is to be included in a electronic publication to a given user (see lines 39-48). Examiner further relies on col.5, lines 66 - col. 6 line 22 of Griebenow to support this additional argument. However, col.5, lines 66 - col. 6 line 22 provides a description of "a message from consumer's computer 12 to publisher's computer 14 indicating that a consumer has accessed the electronic publication ... a content item or an advertisement." That section then proceeds to state that "[t]his feature... used... monitor

consumer response to advertisements or content items" and allows for publishers to bill for advertising based upon consumer's viewing of the advertisement (lines 10-12).

While Appellant would agree that an advertisement can be a serial publication, Appellant would point out that the functionality associated with the advertisement of Giebenow's method is inherently different from the functionality being provided by Appellant's claimed invention. That is, providing an indication that the consumer has accessed advertising content associated with the electronic publication to monitor consumer response and allow for billing of advertising is functionally different from and not suggestive of transmitting a second issue of a publication only when the first issue has been opened.

Also in the Advisory Action, Examiner states that Stumm (U.S. Pat. No. 5,768,528) at col. 6, lines 19-46 teaches the subject matter of Appellant's exemplary Claim 8. Carefull review of that section of Stumm and a general review of Stumm indicates that Stumm fails to teach or suggest the recited features of Appellant's exemplary Claim 8. Stumm provides no teaching or suggestion of the specific features related to electronic publication and transmitting a second issue only after the first issue is opened. For example, the cited section of Stumm describes a scheduler that "determines the time which the last successful task took place" by consulting a log file and "launches the last task that should have been successfully taken place."

The above reasons clearly indicate that neither Giebenow nor Stumm suggests the features of Appellant's exemplary Claim 8 or other features of Appellant's Group I claims. Thus, Appellant's exemplary Claim 8 and all other pending claims are not rendered unpatentable by Griebenow or Stumm and should be allowed. Examiner's rejection of the Group I claims is therefore not well founded and should be reversed.

II. EXAMINER'S REJECTION OF APPELLANT'S GROUP II CLAIMS AS BEING UNPATENTABLE OVER THE COMBINATION OF GRIEBENOW AND HOYLE IS NOT WELL FOUNDED AND SHOULD BE REVERSED.

At paragraph 14 of the Final Office Action, Claims 5-6, 12-13 and 19-21 were rejected under 35 U.S.C. § 103(a), as being unpatentable over Griebenow in view of Hoyle. Again,

Appellant incorporates by reference the arguments proffered in Amendment A and Response B. The combination does not suggest to one skilled in the art the use of an http cookie and cookie response and related functionality, as are recited by exemplary Claim 12.

At pargraph 15 of the Final Action, Examiner clearly states that Griebenow does not teach the use of http cookies. Examiner relies on col. 17, lines 27-45 of Hoyle to support the rejection of these claim features. However, that section of Hoyle does not teach or suggest these claimed features, and Hoyle does not teach specific use of a cookie and cookie response functionality to provide status message about whether an issue of an electronic publication has been opened on a client computer. Rather, that section of Hoyle describes including a user ID in a cookie placed on the user's computer, where the user ID is "stored along with demographic data to identify the user for the purpose of demographically targeting advertising to that user" when the user logs in to the application (emphasis added). Hoyle further states that the "cookie can be accessed by server 22 each time computer usage information is sent to server 22 so that the ID can be associated with the computer usage information" (lines 33-36).
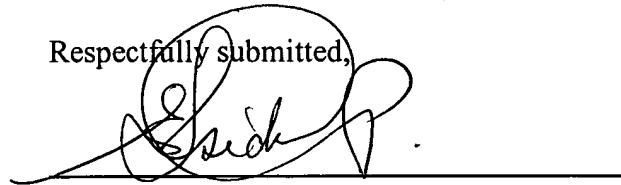
Hoyle clearly fails to suggest (1) a cookie response that is generated and sent when the issue is opened at the subscriber's end. Hoyle's method allows the computer usage information to be compiled and then accessed by the server at some undisclosed interval rather than automatically/immediately sending the "opened" status when the subscriber opens the issue. Hoyle also fails to suggest (2) controlling whether or not to send a second issue based on the receipt of the cookie response indicating the opened status of the first issue. Thus, with Hoyle, while use data along with the user ID is returned to the server via the cookie, the use data and ID are not utilize to determine whether the next issue of the publication may be transmitted.

Appellants have provided arguments indicating why the Examiner has not established prima facie obviousness of the Group II claims. It is clear that the combination of Griebenow and Hoyle fails to teach or suggest key features of Appellant's exemplary Claim 12. Examiner's rejection of Appellants Group II claims are therefore not well founded and should be reversed.

CONCLUSION

Appellant has pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the combination of references. Appellant, therefore, respectfully requests that this case be remanded to the Examiner with instructions to issue a Notice of Allowance with respect to all pending claims.

Respectfully submitted,

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ATTORNEY FOR APPELLANT(S)

APPENDIX

1.   A method in a network of data processing systems for optimizing the efficiency with which a serial electronic publication is distributed to subscribers, said method comprising:

electronically transmitting a first issue of a serial electronic publication to a subscriber;

determining whether said first issue has been opened by said subscriber; and

electronically transmitting a second issue of said serial electronic publication to said subscriber only after determining that said first issue has been opened.

2.   The method of claim 1, wherein:

said step of electronically transmitting said issue comprises electronically transmitting said issue to a client data processing system associated with said subscriber; and

said step of determining whether said first issue has been opened comprises receiving a status update from said client data processing system indicating that said first issue has been opened.

3.   The method of claim 2, wherein:

said method further comprises storing a subscriber status in accordance with said status update, in response to receiving said status update from said client; and

said step of determining whether said first issue has been opened is performed with reference to said subscriber status, such that said subscriber status enables said determination to be performed without communicating with said subscriber after said first issue has been transmitted.

4.   The method of claim 3, wherein:

said method further comprises determining that a publication time for initiating distribution of an issue of said serial electronic publication has been reached; and

said step of determining whether said first issue has been opened is performed in response to said determination that said publication time has been reached.

5. The method of claim 3, wherein:

said step of transmitting said first issue comprises transmitting a hypertext transfer protocol (HTTP) cookie to said subscriber with said first issue; and

said step of receiving said status update comprises receiving a cookie response from said subscriber indicating that client software has been utilized to open said first issue.

6. The method of claim 3, wherein said step of receiving said status update comprises receiving, at a server data processing system, a hypertext transfer protocol (HTTP) function for storing said subscriber status.

7. The method of claim 2, further comprising:

determining that a publication time for initiating distribution of an issue of said serial electronic publication has been reached; and

automatically transmitting a status request to said subscriber in response to said determination that said publication time has been reached;

wherein said step of receiving said status update comprises receiving, from said subscriber, a status reply that corresponds to said status request and comprises said status update.

8. A data processing system with facilities for transmitting a serial electronic publication to subscribers efficiently, said data processing system comprising:

a push engine that electronically transmits a first issue of a serial electronic publication to a subscriber; and

a status manager that determines whether said first issue has been opened by said subscriber, and that allows said push engine to transmit a second issue to said subscriber only after determining that said first issue has been opened.

9. The data processing system of claim 8, wherein:

said data processing system comprises a server data processing system;

said push engine transmits said first issue to said subscriber by transmitting said first issue to a client data processing system associated with said subscriber;

said server data processing system includes an input module that receives a status update from said subscriber; and

said status manager determines whether said first issue has been opened by reference to said status update.

10.   The data processing system of claim 9, wherein:

said server data processing system comprises storage for storing a subscriber status that corresponds to said status update in response to receipt of said status update; and

said push engine determines whether said first issue has been opened by reference to said subscriber status, such that said subscriber status enables said determination to be performed without communicating with said subscriber after said first issue has been transmitted.

11.   The data processing system of claim 10, wherein:

said server data processing system includes a timer that indicates when a publication time for initiating distribution of an issue of said serial electronic publication has been reached; and

said push engine determines whether said first issue has been opened in response to said indication of said timer.

12.   The data processing system of claim 10, wherein:

said push engine transmits a hypertext transfer protocol (HTTP) cookie to said subscriber with said first issue;

said status update comprises a cookie response received from said subscriber; and

said cookie response corresponds to said HTTP cookie and indicates that client software has been utilized to open said first issue.

13.   The data processing system of claim 10, wherein said status update comprises a hypertext transfer protocol (HTTP) function, received at said server data processing system, for storing said subscriber status at said server data processing system.

14.   The data processing system of claim 9, wherein:

said server data processing system includes a timer that indicates when a publication time for initiating distribution of an issue of said serial electronic publication has been reached;

said status manager automatically transmits a status request to said subscriber in response to said indication of said timer;

said input module receives a status reply from said subscriber that corresponds to said status request; and

said status reply comprises said status update.

15.   A program product for efficiently transmitting a serial electronic publication from a server data processing system to subscribers, said program product comprising:

a push engine that electronically transmits a first issue of a serial electronic publication from a server data processing system to a subscriber; and

a status manager that determines whether said first issue has been opened by said subscriber, and that allows said push engine to transmit a second issue to said subscriber only after determining that said first issue has been opened; and

a computer usable medium encoding said push engine and said status manager.

16.   The program product of claim 15, wherein:

said push engine transmits said first issue to said subscriber by transmitting said first issue to a client data processing system associated with said subscriber;

said computer usable medium also encodes an input module that receives a status update from said subscriber; and

said status manager determines whether said first issue has been opened by reference to said status update.

17.   The program product of claim 16, wherein:

said computer usable medium also encodes instructions for allocating storage in said server data processing system for storing a subscriber status that corresponds to said status update;

said status manager stores said subscriber status in said storage in response to receipt of said status update; and

said push engine determines whether said first issue has been opened by reference to said subscriber status, such that said subscriber status enables said determination to be performed without communicating with said subscriber after said first issue has been transmitted.

18.   The program product of claim 17, wherein:

said server data processing system includes a timer that indicates when a publication time for initiating distribution of an issue of said serial electronic publication has been reached; and

said push engine determines whether said first issue has been opened in response to said indication of said timer.

19.   The program product of claim 17, wherein:

said push engine transmits a hypertext transfer protocol (HTTP) cookie to said subscriber with said first issue;

said status update comprises a cookie response received from said subscriber; and

said cookie response corresponds to said HTTP cookie and indicates that client software has been utilized to open said first issue.

20.   The program product of claim 17, wherein said status update comprises a hypertext transfer protocol (HTTP) function, received at said server data processing system, for storing said subscriber status at said server data processing system.

21.   The program product of claim 20, wherein:

said server data processing system includes a timer that indicates when a publication time for initiating distribution of an issue of said serial electronic publication has been reached;

said status manager automatically transmits a status request to said subscriber in response to said indication of said timer;

said input module receives a status reply from said subscriber that corresponds to said status request; and

said status reply comprises said status update.